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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,511	01/25/2001	Bjorn Markus Jakobsson	31	6106

7590 11/03/2006

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EXAMINER	
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ART UNIT	PAPER NUMBER
3628	

DATE MAILED: 11/03/2006

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/769,511
Filing Date: January 25, 2001
Appellant(s): JAKOBSSON, BJORN MARKUS

Michael L. Wise
For Appellant

This is in response to the appeal brief filed 05/12/2006 appealing from the Office action mailed 12/30/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

For the above reasons, it is believed that the rejections should be sustained.

US 5,568,541	Greene	10-1996
US 6,240,402	Lynch-Aird	05-2001
US 5,958,016	Chang et al.	09-1998
US 6,595,424	Harrison	07-2003
US 5,148,474	Haralambopoulos et al.	09-1992

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 2-5, 8-12, and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greene (US Patent Number 5,568,541) in view of Lynch-Aird (US Patent Number 6,240,402) in further view of Chang et al. (US Patent Number 5,958,016).

As per claims 3-4, 8-9, and 16-18, Greene discloses the method wherein the access cost is charged to the originator and credit at least in part to an account of a called party associated with the user terminal (col. 3, lines 39-44) *{that when answered, the telephone number of the calling party is identified electronically in step 6 and compared to the subscriber's database in a data processing system as indicated by box 8}*; (col. 2, line 61-67) *{the subscriber's specified call billing parameters are then incorporated into a standard Automatic Message Accounting record which is generated by the carrier switch network for each call and sent to the billing system which processes the charges for inclusion in the network bill sent to the caller and credits a portion of those charges to the account of the person called}.*

Greene does not disclose that the user-specified access cost information includes one or more access rules specified by the user and indicates a particular access cost for an incoming call under one or more specified conditions. Greene et al. does not further disclose that the user-specified access cost information is at least in part entered by the user at a web site associated with a service provider.

Lynch-Aird discloses that charging information can be maintained by the network operator in a suitable charging table in which an entry is kept against each allocated recipient identifier indicating the charging scheme associated with the recipient identifier wherein for example, a first unique recipient identifier RID.sub.1 is allocated to recipient R.sub.A and designates that the originator of the call be charged (col. 5, lines 27-33; FIG. 4); the charges are determined on the basis of any known system, for example a fixed charged per packet, the charge based on the duration of the packet, a charge based on the distance of the call, the time of the day, the packet type and so forth (col. 6, lines 10-14); an originator identifier indicates that the corresponding customer originated the call and will accept the call charging scheme as determined by the recipient identifier (col. 4, lines 60-63); and a recipient identifier indicates that the corresponding customer received the call and would also determine how the call charges should be allocated (col. 4, lines 64-67).

Chang et al. discloses a web page type which enables subscriber access to control and reporting functionalities of a communication network, such as the advanced intelligent telephone network, via a public packet data network, typically the network now commonly known as the Internet; and the web page based Internet access opens the personal control of services provided by the communication network to any subscriber who also uses the Internet, for example using the subscriber's existing PC and browser software or their Web-TV terminal (abstract). Chang et al. further disclose that through the web page access provided by the platform, telephone subscribers can review the status of their services and modify or upgrade their telephone services, including switch-based services and intelligent network services controlled through the data stored in the service control point. Subscribers also may review reports of usage of their services or review account or billing statements (col. 6, lines 23-29).

Therefore, it would have obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Greene to include the feature of Lynch-Aird and Chang et al. in order to provide recipient identifiers to indicate that the corresponding customer received the call and to determine which party pays, as well as, providing the subscriber with online capabilities to modify their service. (Lynch-Aird; col. 6, lines 17-35).

As claims 2 and 10, Greene discloses the method of claim 16 wherein the access cost is presented to the originator of the given incoming call and the incoming call is routed to the user terminal only if the presented access cost is approved by the originator of the incoming call (col. 3, lines 46-54) *{give call and the incoming call is that if the number of the calling party is not on the list of pre-approved number, the call is identified as a telephone solicitation in step 8, and the automated answering system advises the person making the call that a surcharge may or will (at the subscriber's option) be added to their as indicated at box 10. The caller then has the opportunity at step 12 to continue the call and accept the surcharge}.*

As per claims 5 and 15, Greene discloses the method of claim 16 wherein the user terminal comprises a computer (col. 2, lines 18-22) *{the method and system allows the subscriber to program the system to include a plurality of telephone numbers which will automatically bypass the billing portion of the system}.*

Greene does not explicitly disclose that user-specified access control information is entered by the user at the user terminal via a menu-driven user interface.

However, it would have been obvious to one of ordinary skill in the art that a menu-driven user interface was an old and well-known type of user interface in the computer art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide user friendly menus for the users to input data.

As per claim 11, Greene discloses the method of claim 16 wherein a user associated with the terminal is permitted to waive the access cost for the given incoming call (col. 3, lines 64-67) *{the subscriber has an option in step 13 to void or waive the surcharge as for example by, pressing one or more keys on his telephone key pad}.*

As per claim 12, Greene discloses the method of claim 11 wherein the waiver of the access cost is in response to an offer from the call originator made after the incoming call is routed to and accepted at the user terminal (col. 3, lines 67 through col. 4, line 4) *{if the subscriber is sympathetic to a particular charity or solicitation, he or she may void the surcharge at any time during the conversation by causing the call to bypass the billing and crediting functions as shown in steps 14 and 16}.*

As per claim 19, Greene discloses an apparatus for use in controlling access to call originators to terminals in a communication system, the apparatus comprising:

A memory for storing for a given user terminal of the system a set of user-specified access cost information to be applied to one or more incoming calls directed to the user terminal (col. 3, lines 39-44) *{when answered, the telephone number of the calling party is identified electronically in step 6 and compared to the subscriber's database in a data processing system as indicated by box 8}*;

A processor coupled to the memory and operative to determine an amount to charge an originator of a given incoming call directed to the user terminal based at least in part on an access cost for the given incoming call as determined from the user-specified access cost information (col. 2, lines 61-67) *{the subscriber's specified call billing parameters are then incorporated into a standard Automatic Message Accounting record which is generated by the carrier switch network for each call and sent to the billing system which processes the charges for inclusion in the network bill sent to the caller and credits a portion of those charges to the account of the person called}.*

Greene does not disclose that the user-specified access cost information includes one or more access rules specified by the user and indicates a particular access cost for an incoming call under one or more specified conditions. Greene et al. does not further disclose that the user-specified access cost information is at least in part entered by the user at a web site associated with a service provider.

Lynch-Aird discloses that charging information can be maintained by the network operator in a suitable charging table in which an entry is kept against each allocated recipient identifier indicating the charging scheme associated with the recipient identifier wherein for example, a first unique recipient identifier RID.sub.1 is allocated to recipient R.sub.A and designates that the originator of the call be charged (col. 5, lines 27-33; FIG. 4); the charges are determined on the basis of any known system, for example a fixed charged per packet, the charge based on the duration of the packet, a charge based on the distance of the call, the time of the day, the packet type and so forth (col. 6, lines 10-14); an originator identifier indicates that the corresponding customer originated the call and will accept the call charging scheme as determined by the recipient identifier (col. 4, lines 60-63); and a recipient identifier indicates that the corresponding customer received the call and would also determine how the call charges should be allocated (col. 4, lines 64-67).

Chang et al. discloses a web page type which enables subscriber access to control and reporting functionalities of a communication network, such as the advanced intelligent telephone network, via a public packet data network, typically the network now commonly known as the Internet; and the web page based Internet access opens the personal control of services provided by the communication network to any subscriber who also uses the Internet, for example using the subscriber's existing PC and browser software or their Web-TV terminal (abstract). Chang et al. further disclose that through the web page access provided by the platform, telephone subscribers can review the status of their services and modify or upgrade their telephone services, including switch-based services and intelligent network services controlled through the data stored in the service control point. Subscribers also may review reports of usage of their services or review account or billing statements (col. 6, lines 23-29).

Therefore, it would have obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Greene to include the feature of Lynch-Aird and Chang et al. in order to provide recipient identifiers to indicate that the corresponding customer received the call and to determine which party pays, as well as, providing the subscriber with online capabilities to modify their service. (Lynch-Aird; col. 6, lines 17-35).

2. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Greene (US Patent Number 5,568,541) in view of Lynch-Aird (US Patent Number 6,240,402) in further view of Chang et al. (US Patent Number 5,958,016), still in further view of Harrison (US Patent Number 6,595,424).

As per claim 6, Greene does not disclose that the user terminal includes a personal digital assistant.

However, Harrison discloses a device which provides a wireless telephone (col. 3, lines 65-67). Harrison further discloses that this type of armpiece is particularly well-suited for use with pre-existing PDA's and handheld computers.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Greene to include the device of Harrison to provide a more convenient or portable user terminal.

3. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greene (US Patent Number 5,568,541) in view of Lynch-Aird (US Patent Number 6,240,402) in further view of Chang et al. (US Patent Number 5,958,016) in further view of Harrison (US Patent Number 6,595,424), still in further view of Haralambopoulos et al. (US Patent Number 5,148,474).

As per claims 13-14, Greene does not disclose that the user specified access control information comprises a caller-specific access cost, a caller- specific access rule, general access cost, or a general access rule.

However, Haralambopoulos et al. disclose that the service provider (called party) has a plurality of individual value-added telephone numbers with each representing a different billing rate to reflect the services rendered (col. 5, lines 48-52). Haralambopoulos et al. further disclose that in addition to time related billing rates, the service provider (called party) may have numbers which enable a single item charge, for instance, if the service provider is a doctor, he may have three different time dependent billing rates for clients depending on the types of information required and a single use rate for a prescription renewal (col. 5, lines 52-61).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the system of Green to include the system Haralambopoulos et al. in order to store the caller-specified costs and rules in database associated with the user terminal to provide the user the convenience to modify or change charges and rules.

(10) Response to Argument

1. Independent Claim 16:

Appellant's arguments appearing on Page 6 of the appeal brief is that in claim 16, Lynch-Aird does not contribute to a valid 103 (a) rejection because Lynch-Aird fails to specify that access cost information be user-specified and Lynch–Aird teaches away from claim 16.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to appellant's arguments, the examiner asserts that it is Greene who teaches that "*the subscriber's specified call billing parameters are then incorporated into a standard Automatic Message Accounting record which is generated by the carrier switch network for each call and sent to the billing system which processes the charges for inclusion in the network bill sent to the caller and credits a portion of those charges to the account of the person called*"; and it is Lynch-Aird who teaches a particular access cost to be applied to one or more incoming calls *{charging information can be maintained by the network operator in a suitable charging table in which an entry is kept against each allocated recipient identifier indicating the charging scheme associated with the recipient identifier wherein for example, a first unique recipient identifier RID.sub.1 is allocated to recipient R.sub.A and designates that the originator of the call be charged (col. 5, lines 27-33)."*

Appellant's arguments appearing on Page 7 of the appeal brief is that in claim 16, Greene refers to "subscriber's specified billing parameters" **rather than** subscriber-specified call billing parameter. The examiner believes that "rather than" means "other than", yet the appellant has not supplied the examiner with another option. The examiner is unable to determine the difference between "subscriber's specified" and subscriber-specified".

The appellant continues to argue (on page 7) that Greene does not disclose "a particular access cost for an incoming call under one or specified conditions"

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a particular access cost for an incoming call under one or specified conditions) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Appellant's arguments appearing on Page 8 of the appeal brief is that in claim 16, the examiner provided no motivation to combine Chang with the aspects of Greene and Lynch-Aird.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case,

2. Dependent Claim 9:

Appellant's arguments appearing on Page 9 of the appeal brief is that in claim 9, the examiner fails to point with any level of specificity where the proposed reference combination teaches or suggests this limitation.

In response to applicant's arguments, the examiner asserts that Greene teaches that The subscriber's specified call billing parameters are then incorporated into a standard Automatic Message Accounting record which is generated by the carrier switch network for each call and sent to the billing system which processes the charges for inclusion in the network bill sent to the caller and credits a portion of those charges to the account of the person called (col. 2, lines 61-67).

3. Dependent Claim 12:

Appellant's arguments appearing on Page 9 of the appeal brief is that in claim 12, Greene does not teach or suggest that "the waiver of the access cost is in response to an offer from a call originator made after the incoming call is routed to and accepted at the user terminal".

In response to the appellant's argument, the examiner asserts that Greene teaches "in FIG. 2, the subscriber has an option in step 13 to void or waive the

surcharge as for example, by pressing one or more keys on his telephone key pad (col. 3, lines 67 through col. 4, line 4); and if the subscriber is sympathetic to a particular charity or solicitation, he or she may void the surcharge at any time during the conversation by causing the call to bypass the billing and crediting functions as shown in steps 14 and 16 (col. 3, lines 67 through col. 4, line 4).

4. Dependent Claim 6:

Appellant's arguments appearing on Page 10 of the appeal brief is that in claim 6, Harrison fails to remedy the fundamental deficiencies of Greene, Lynch-Aird, and Chang.

In response to appellant's argument, the examiner asserts that Harrison discloses "a device which provides a wireless telephone" (col. 3, lines 65-67). Harrison further discloses that this type of armpiece is particularly well-suited for use with pre-existing PDA's and handheld computers (col. 24, lines 45-46). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Greene to include the device of Harrison to provide a more convenient or portable user terminal.

5. Dependent Claims 13-14:

Appellant's arguments appearing on Page 10 of the appeal brief is that in claim 6, Harrison and Haralambopoulos et al. fail to remedy the fundamental deficiencies of Greene, Lynch-Aird, and Chang.

In response to appellant's argument, the examiner asserts that Haralambopoulos et al. disclose that "the service provider (called party) has a plurality of individual value-added telephone numbers with each representing a different billing rate to reflect the services rendered" (col. 5, lines 48-52); and "in addition to time related billing rates, the service provider (called party) may have numbers which enable a single item charge, for instance, if the service provider is a doctor, he may have three different time dependent billing rates for clients depending on the types of information required and a single use rate for a prescription renewal "(col. 5, lines 52-61). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the system of Green to include the system Haralambopoulos et al. in order to store the caller-specified costs and rules in database associated with the user terminal to provide the user the convenience to modify or change charges and rules.

Appellant's arguments appearing on Page 11 of the appeal brief is that in claim 6, Haralambopoulos et al. "by depending on user actions instead of an automated process, substantially changes the principle of the operation of Greene".

In response to appellant's arguments, the examiner asserts that It was known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of scoring the insurance policy based upon the information from the customer and policy gives you just what you would expect from the manual

step as shown in Reference A. In other words there is no enhancement found in the claimed step. The claimed scoring step only provides automating the manual activity. Likewise, automating the iterating step (step 3) only gives just what one would expect from the manual steps shown in the reference. The end result is the same as compared to the manual method. A computer can simply iterate the steps faster. The result is the same.

Therefore, it would have been obvious to a person of ordinary still in the art at the time of the invention to use automation because this would speed up the process of assigning billing rates, which is purely known, and an expected result from automation of what is known in the art.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Freda A. Nelson

Freda A Nelson

Conferees:

John W. Hayes

John Weiss

JOHN W. HAYES
SUPERVISORY PATENT EXAMINER